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10/675,673

09/30/2003

Dustin C. Kirkland

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06/20/2006

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EXAMINER

WONG, NOBLE S

ART UNIT

PAPER NUMBER

2193

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

Application No.

10/675,673

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| <b>Applicant(s)</b> |  |
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KIRKLAND, DUSTIN C.

**Examiner**

**Noble S. Wong**

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| Art Unit |  |
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2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 9/30/03.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:
  - a. The term “messenger” is misspelled (page 1, line 20). It is understood to be “messenger”.
  - b. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Misnumbered claim 17 should be renumbered 18.

Appropriate correction is required.

### ***Claim Objections***

2. Claim 20 is objected to because of the following informalities: there is lack of a modifier for “preexisting database of pictures.” It is understood to be “the preexisting database of pictures.” Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Crawford (US Patent # 6,781,608 B1).

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5. As to claim 1, Crawford discloses a method in a data processing system (communications system 500) for handling instant messages (i.e. instant messages handled by IM host complex 390 see col. 5 lines 54-56), the method comprising:

- responsive to receiving (step 745) an instant message, determining whether a picture (i.e. buddy icon 1110 see col. 13 lines 14-20 and col. 17 line 35) of a sender (client 702a) of the instant message is associated with the message (step 735), wherein the picture is located in a preexisting database (i.e. "Online Service Provider or Internet" see col. 13 lines 52-63) of pictures;
- and displaying the picture with the message on a display (display 295) in the data processing system if the picture is associated with the message (i.e. col. 17 lines 31-38).

As to claim 10, Crawford discloses a data processing system (communications system 500) for handling instant messages (i.e. instant messages handled by IM host complex 390 see col. 5 lines 54-56), the data processing system comprising:

- determining means (step 735), responsive to receiving (step 745) an instant message, for determining whether a picture (i.e. buddy icon 1110 see col. 13 lines 14-20 and col. 17 line 35) of a sender (client 702a) of the instant message is associated with the message (i.e. "authenticate message" step 735), wherein the picture is located in a preexisting database (i.e. "Online Service Provider or Internet" see col. 13 lines 52-63) of pictures;
- and displaying means (display 295) for displaying the picture with the message on a display in the data processing system if the picture is associated with the message (i.e. col. 17 lines 31-38).

As to claim 16, Crawford discloses a computer program product (client application 278) in a computer readable medium (internal or external storage 272) for handling instant messages (i.e. instant messages handled by IM host complex 390 see col. 5 lines 54-56) in a data processing system (communications system 500), the computer program product comprising:

- first instructions, responsive to receiving (step 745) an instant message, for determining whether a picture (buddy icon 1110) of a sender (client 702a) of the instant message is associated with the message (step 735), wherein the picture is located in a preexisting database (i.e. "Online Service Provider or Internet" see col. 13 lines 52-63) of pictures;

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- and second instructions (i.e. col. 17 lines 31-38) for displaying the picture with the message on a display (display 295) in the data processing system if the picture is associated with the message.

As to claim 9, Crawford discloses a data processing system (communications system 500) for handling instant messages (i.e. instant messages handled by IM host complex 390 see col. 5 lines 54-56), the data processing system comprising:

- a bus system (i.e. “client controller 225 [are] for controlling the client devices 220” see col. 3 lines 44-47);
- a communications unit (communication device 284) connected to the bus system;
- a memory (internal or external storage 272) connected to the bus system, wherein the memory includes a set of instructions (client applications 278);
- and a processing unit (CPU 282) connected to the bus system,
  - wherein the processing unit executes the set of instructions to determine whether a picture (buddy icon 1110) of a sender (client 702a) of the instant message is associated with the message (step 735) in response to receiving (step 745) an instant message,
  - wherein the picture is located in a preexisting database (i.e. “Online Service Provider or Internet” see col. 13 lines 52-63) of pictures,
  - and display the picture with the message (i.e. in message dialogue box 1105) on a display (display 295) in the data processing system if the picture is associated with the message (i.e. col. 17 lines 31-38).

As to claim 2, Crawford teaches the method of claim 1, wherein the picture and the message are displayed in a single window (i.e. see Fig. 11 and col. 13 lines 12-20).

As to claim 3, Crawford teaches the method of claim 1, wherein the picture is received (i.e. step 745) with the message from the sender (client 702a).

As to claim 4, Crawford teaches the method of claim 1, wherein the picture of the sender is stored in at least one of a local cache (i.e. graphics file see col. 13 lines 57-59, since applicant states in the specification, “These image files act as a cache for the pictures,” see p. 13 lines 3-4) on the data processing system.

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As to claim 5, Crawford teaches the method of claim 1, wherein the picture is embedded by an instant messaging process (step 725) of the sender into the message prior to sending the message to the data processing system.

As to claim 7, Crawford teaches the method of claim 1 further comprising: receiving (step 745) the picture with the instant message.

As to claim 8, Crawford teaches the method of claim 7 (see claim 7 above), wherein the picture is received in response to a request made by a user receiving the instant message (i.e. see col. 17 lines 14-18, "Referring to FIG. 9, a UI 900 includes a Buddy Icon preference box 905. In one implementation, the Buddy Icon preference box 905 is used to designate a buddy icon (image) for a selected buddy (sender)." In this figure, the receiver can request to have a custom image for a sender, where the image selection is browsed in the "Buddy Icons Center" panel, with icons from i.e. "Online Service Provider or Internet" see col. 13 lines 52-63).

As to claim 11, Crawford teaches the data processing system of claim 10, wherein the picture and the message are displayed (i.e. see Fig. 11 and col. 13 lines 12-20) in a single window.

As to claim 12, Crawford teaches the data processing system of claim 10, wherein the picture is received (i.e. step 745) with the message from the sender.

As to claim 13, Crawford teaches the data processing system of claim 10, wherein the picture of the sender is stored in a local cache (i.e. graphics file see col. 13 lines 57-59, since applicant states in the specification, "These image files act as a cache for the pictures," see p. 13 lines 3-4) on the data processing system (communications system 500).

As to claim 14, Crawford teaches the data processing system of claim 10, wherein the receiving means and the displaying means are located in an instant messaging application (client application 278) on the data processing system.

As to claim 15, Crawford teaches the data processing system of claim 10 wherein the preexisting database of pictures is stored externally to the data processing system (i.e. "Internet" see col. 13 lines 52-63).

As to claim 17, Crawford teaches the computer program product of claim 16, wherein the picture and the message are displayed (i.e. see Fig. 11 and col. 13 lines 12-20) in a single window.

As to claim [18], Crawford teaches the computer program product of claim 16, wherein the picture is received (i.e. step 745) with the message from the sender.

As to claim 19, Crawford teaches the computer program product of claim 16, wherein the picture of the sender is stored in a local cache (i.e. graphics file see col. 13 lines 57-59, since applicant states in the specification, "These image files act as a cache for the pictures," see p. 13 lines 3-4) on the data processing system.

As to claim 20, Crawford teaches the computer program product of claim 16, wherein [the] preexisting database of pictures is external to the data processing system (i.e. "Internet" see col. 13 lines 52-63).

As to claim 21, Crawford teaches the computer program product of claim 16 further comprising: third instructions (i.e. step 745) for receiving the picture with the instant message.

As to claim 22, Crawford teaches the computer program product of claim 16, wherein the preexisting database also is used for a different purpose (i.e. "Internet" see col. 13 lines 52-63,

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since the Internet is also used for transmitting webpages. Also, “the IM host complex 590 also includes a subscriber profile server 5912 connected to a database 5914 for storing large amounts of subscriber profile data. The subscriber profile server 5912 may be used to enter, retrieve, edit, manipulate, or otherwise process subscriber profile data. In one implementation, a subscriber's profile data includes, for example, the subscriber's buddy list, alert preferences, designated stocks, identified interests, and geographic location.” See col. 11 lines 35-46).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford (US Patent 6,781,608 B1) in view of Ball et al. (US Pub #2002/0126135 A1).

As to claim 6, Crawford teaches the method of claim 1, but does not teach wherein the determining step is performed by an instant messaging process of a receiver of the message and determines whether the picture is in the pre-existing database of pictures. Ball teaches wherein the determining step (i.e. step 744 see [0260]) is performed by an instant messaging process of a receiver (recipient software 740) of the message and determines whether the picture is in the pre-existing database of pictures (image server 732).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the determining step of Ball in place of the determining step of



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Crawford's since, "Users typically share these images with one another using e-mail or instant messaging attachments." (I.e. see [0003] – [0005])

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

ICQ instant messaging product (Referred in "Instant Messaging" by Alan Cohen, PC Magazine, p. 171, 5 May 1999) discloses where messages (including possible pictures) are stored on a database when the second user is offline.

Leahy et al. (US Patent # 6,219,045 B1) discloses an instant messaging product where users can choose user images (avatars) stored in fixed avatar image database 71 or custom avatar images database 108.

### ***Inquiries***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noble S. Wong whose telephone number is (571) 270-1044. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

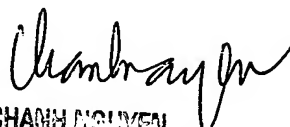
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NKW

Noble Wong

8 June 2006

  
CHANH NGUYEN  
PRIMARY EXAMINER